

Appl. No. 08/972,313
Amdt. dated October 14, 2003
Reply to Office Action of June 19, 2003

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figure 1 and Figure 1A. This sheet replaces the original sheet including Figure 1 and Figure 1A.

Attachment: Replacement Sheet

REMARKS/ARGUMENTS

Claims 1-9, 13-20, and 23-27 are pending in the present application. Claims 1-9, 13-20, and 23-27 have been rejected.

In this Amendment and Response, claims 1, 15, and 16 are amended to recite “an object” and to specify that the two dimensional graphical code is “displayed on the object.” Support for these amendments can be found in Applicants’ specification on, for example, page 7, lines 9-11. Claims 1, 15, and 16 are also amended to specify that the additional information “is separate from the Internet address” and “comprises a unique characteristic of the object.” Support for these amendments can be found in Applicants’ specification on, for example, page 6, line 19 through page 7, line 6. Claims 1 and 16 are also amended to specify “automatically send[ing] the decoded additional information to the Internet address.” Support for these amendments can be found in Applicants’ specification on, for example, page 11, lines 12-15.

In this Amendment and Response, claims 14, 17, 20, and 25-27 are cancelled.

Applicants respectfully respond to this Office Action.

Rejection of Claims 1-9, 13-20, and 23-27 Under 35 U.S.C. § 112

The Examiner rejected claims 1-9, 13-20, and 23-27 under 35 U.S.C. § 112, second paragraph. Claims 1, 15, and 16 have been amended. Claims 14, 17, 20, and 25-27 have been cancelled. Applicants respectfully submit that claims 1-9, 13, 15-16, 18-19, and 23-24 fully comply with 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

Objection to the Drawings

The Examiner objected to the drawings. A replacement sheet of drawings is included with this Response. The attached replacement sheet includes changes to Figure 1 and Figure 1A and replaces the original sheet including Figure 1 and Figure 1A. Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

Rejection of Claims 1-2, 4-6, 9, and 15-16 Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-2, 4-6, 9, and 15-16 under 35 U.S.C. § 102(e) based on U.S. Patent No. 5,869,819 to Knowles et al. (hereinafter, "Knowles"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (Aug. 2001) (quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Id. (quoting Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that Knowles does not disclose every element of claim 1. Claim 1 recites a two-dimensional graphical code displayed on an object. The graphical code comprises an encoded Internet address and additional information. Claim 1 additionally recites that the additional information "is separate from the Internet address" and "comprises a unique characteristic of the object." Knowles does not disclose these limitations.

Knowles discloses a "Web-based package routing, tracking and delivering system and method that uses URL/ZIP-CODE encoded bar code symbols on parcels and packages." Knowles, abstract. The zip code is not "additional information" within the meaning of claim 1 because the zip code is not "a unique characteristic of the object." Rather, the zip code is a characteristic of the postal delivery area where the package is being sent. *See* Knowles, col. 20, lines 46-48 ("In the U.S. Postal System, and United Parcel Service (UPS) system, the package destination is specified by the ZIP CODE of the destination address.") Packages that are being sent to the same postal delivery area

are labeled with the same zip code. Therefore, the zip code in a bar code on a particular package cannot be considered to be “unique” to that package.

Knowles also discloses the following:

[T]he URL encoded within the bar code symbol is used to specify the location of an information storage field 58 represented on a statically-defined HTML-encoded information field 59 on a web-page stored on the RTD Information Server 51 and served to client subsystems by HTTP Server 60. The size of each Web-based information storage field 58 is sufficient to store ASCII information describing the unique product identification number assigned to the corresponding product being routed and tracked within the system. The RTD information record in the RDBMS 55 associated with any particular package is linked to the URL by the product identification number stored at the information field specified by the URL.

Knowles, col. 20, lines 5-17. The URL discussed in this passage does not include “additional information compris[ing] a unique characteristic of the object,” as recited in claim 1, because claim 1 requires that the “additional information ... is separate from the Internet address.” Moreover, the unique product identification number discussed in this passage is not “additional information compris[ing] a unique characteristic of the object” because it is not included within the bar code, as required by claim 1. In contrast, the unique product identification number in Knowles is included in a Web-based information storage field 58 that is specified by the URL in the bar code.

Claim 1 also recites a computer that is configured to “automatically send the decoded additional information to the Internet address.” Knowles also does not disclose this limitation. Knowles discloses the following:

As indicated at Block A of FIG. 16, the bar code scanner at the Package Routing Subsystem reads the URL/ZIP Code encoded bar code symbol on the package and obtains the information representative of the URL and the Zip Code. Then, at Block B, the Package Routing Subsystem uses the locally-recovered Zip Code to route the package at the Package Routing Subsystem at the hub station of the system. Then at Block C, the Routing Subsystem uses the obtained URL to access the RTD Internet Server by way of HTTP and update the location of the scanned package within the RDBMS of the system. Each time the package is scanned at a different Package Routing Subsystem, or other Internet Scanning Terminal located within the RTD

system, the current location of the scanned package within the System is updated, by ensuring that each HTTP request sent to the RTD Internet Server (by the Package Routing Subsystem) includes information identifying the requesting Package Routing Subsystem.

Knowles, col. 22, lines 11-28. In claim 1, the “decoded additional information” that is sent to the Internet address is obtained from the “graphical code.” In the Knowles reference, in contrast, the information that is sent to the RTD Internet Server is not obtained from the bar code. The information that is sent to the RTD Internet Server identifies the Package Routing Subsystem. Applicants cannot find any portion of Knowles which indicates that the bar code includes any information about the Package Routing Subsystem. Moreover, because packages likely travel through several Package Routing Subsystems on the way to their respective destinations, and because these Package Routing Subsystems may be unknown to the person creating the bar code, it seems highly unlikely that the bar code in Knowles could include information about a Package Routing Subsystem.

Knowles also discloses the following:

Then at Block B, the Package Log-in/Shipping Computer 52 is used to send the identified destination ZIP CODE for the package to the RTD Server 51. ... Then at Block D, the Package Log-In/Shipping Computer 52 encodes the URL and the ZIP CODE (associated with the package identification number) within a bar code symbol information structure of either 1-D or 2-D bar code symbology, and then prints out the bar code symbol on a label.

Knowles, col. 21, lines 46-59. The above passage does not disclose “automatically send[ing] the decoded additional information to the Internet address,” as recited in claim 1. Rather, in Knowles the zip code is sent to the RTD server before the zip code is encoded in the bar code. Thus, even if the zip code could be considered to be “additional information,” Knowles does not disclose sending “decoded additional information” to the RTD server, as required by claim 1.

The following passage from Knowles further demonstrates that the decoded zip code is not sent to the RTD server:

The reason that ZIP CODE information is encoded in the bar code symbol (along with the URL) is that the ZIP CODE can be locally recovered very

quickly at a Package Routing Subsystem 53 and used to route packages moving along the conveyor belt system at high speeds.

Knowles, col. 22, lines 55-60. It is clear from this passage that the Package Routing Subsystem uses the decoded zip code to determine how the package should be routed. However, Knowles does not teach that the Package Routing Subsystem sends the decoded zip code to the RTD server. Thus, Knowles does not disclose “automatically sending the decoded additional information” to the RTD server.

Because Knowles does not disclose all of the limitations in claim 1, Applicants respectfully request that the rejection of claim 1 be withdrawn. Claims 2, 4-6, and 9 depend either directly or indirectly from claim 1. Thus, Applicants respectfully request that the rejection of claims 2, 4-6, and 9 be withdrawn for at least the same reasons.

Applicants respectfully submit that Knowles does not disclose every element of claim 15. Claim 15 recites a two-dimensional graphical code displayed on an object. The graphical code comprises an encoded Internet address and additional information. Claim 15 additionally recites that the additional information “is separate from the Internet address” and “comprises a unique characteristic of the object.” As explained above, Knowles does not disclose these limitations. Because Knowles does not disclose all of the limitations in claim 15, Applicants respectfully request that the rejection of claim 15 be withdrawn.

Applicants respectfully submit that Knowles does not disclose every element of claim 16. Claim 16 recites a two-dimensional graphical code displayed on an object. The graphical code comprises an encoded Internet address and additional information. Claim 16 also recites that the additional information “is separate from the Internet address” and “comprises a unique characteristic of the object.” As explained above, Knowles does not disclose these limitations. Claim 16 also recites “sending the decoded additional information to the Internet address.” As explained above, Knowles also does not disclose this limitation. Because Knowles does not disclose all of the limitations in claim 16, Applicants respectfully request that the rejection of claim 16 be withdrawn.

Rejection of Claims 3, 7, 8, 13-14, 17-20, and 23-27 Under 35 U.S.C. § 103

The Examiner rejected claims 3, 7, 8, 13-14, 17-20, and 23-27 under 35 U.S.C. § 103 based on Knowles. Claims 14, 17, 20, and 25-27 have been cancelled. With respect to claims 3, 7, 8, 13, 18-19, and 23-24, this rejection is respectfully traversed.

The M.P.E.P. states that

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142 (August 2001). A prima facie case of obviousness has not been established regarding claims 3, 7, 8, 13-14, 17-20, and 23-27 because the prior art cited does not teach or suggest all the claim limitations.

Claims 3, 7, 8, and 13 depend either directly or indirectly from claim 1. Claim 1 recites a two-dimensional graphical code displayed on an object. The graphical code comprises an encoded Internet address and additional information. Claim 1 also recites that the additional information “is separate from the Internet address” and “comprises a unique characteristic of the object.” As discussed above, Knowles does not teach or suggest these limitations. Claim 1 also recites “automatically send[ing] the decoded additional information to the Internet address.” As explained above, Knowles does not teach or suggest this limitation. As a result, a prima facie case of obviousness has not been established regarding claims 3, 7, 8, and 13 because the cited prior art does

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not teach or suggest all the claim limitations. Accordingly, Applicants respectfully request that the rejection of claims 3, 7, 8, and 13 be withdrawn.

Claims 18-19 and 23-24 depend either directly or indirectly from claim 16. Claim 16 recites a two-dimensional graphical code displayed on an object. The graphical code comprises an encoded Internet address and additional information. Claim 16 also recites that the additional information “is separate from the Internet address” and “comprises a unique characteristic of the object.” As discussed above, Knowles does not teach or suggest these limitations. Claim 16 also recites “automatically sending the decoded additional information to the Internet address.” As discussed above, Knowles does not teach or suggest this limitation. As a result, a prima facie case of obviousness has not been established regarding claims 18-19 because the cited prior art does not teach or suggest all the claim limitations. Accordingly, Applicants respectfully request that the rejection of claims 18-19 and 23-24 be withdrawn.

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Applicants respectfully assert that claims 1-9, 13, 15-16, 18-19, and 23-24 are patentably distinct from the cited references, and requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', is written over a horizontal line.

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